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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,921	09/28/2001	Yongxia Wang	1898	4216

7590 06/10/2003
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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,921

Applicant(s)

WANG ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 27, 2003 has been entered.

2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 depends from canceled claim 3.

3. Claims 1 and 4-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of polyurethane hot melt adhesives, does not reasonably provide enablement for hot melt adhesives that are not polyurethanes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Throughout the specification, applicants have referred only to the use and production of polyurethane adhesives. Accordingly, the specification is devoid of any guidance that would instruct one of ordinary skill in the art how to produce non-polyurethane adhesives without having to resort to undue experimentation. The position is taken that the claims should be limited to the invention for which applicants have provided enablement.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merz et al. ('873) in view of Aoyama et al. ('219) or Fuhr et al. ('951) or Fesman ('105 or '044 or '485), each further in view of Lee ('040).

Merz et al. disclose reactive hot-melt polyurethane adhesives comprising the reaction product of polyisocyanates with polyols, in combination with thermoplastic materials, including acrylate polymers, and flame retardants. See abstract; column 2, lines 20+; column 3, lines 35+; and column 4, line 21.

6. Though the primary reference discloses that flame retardants may be used within the adhesive, the reference is silent with respect to the species of flame retardants. However, Aoyama et al., Fuhr et al., and Fesman each disclose the use of applicants' claimed flame retardants within polymeric compositions. Fuhr et al. and Fesman further disclose polyurethanes

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as being suitable polymeric species. See columns 2 and 3 within Aoyama et al. See column 2 within Fuhr et al. See column 5 within Fesman. Since it has been held that it is *prima facie* obvious to utilize a known component for its known function (In re Linder, 173 USPQ 356; In re Dial et al., 140 USPQ 244), it would have been obvious to incorporate the flame retardants of the secondary references into the adhesive of Merz et al. Furthermore, Lee discloses at column 3, lines 58+ that the effectiveness of brominated flame retardants, such as ethylene bistetrabromophthalimide, can be increased by adding antimony oxide into the composition. Accordingly, it would have been obvious to incorporate the additionally claimed (claims 6 and 10) flame retardants into the adhesive of Merz et al.

7. The examiner has considered applicants' response; however, the position is maintained that the combined teachings of the relied upon references are adequate to render the instant invention *prima facie* obvious, and applicants have not provided showings of unexpected results attributable to the use of the claimed flame retardants within polyurethane hot melt adhesives to rebut the *prima facie* case of obviousness. Applicants have provided no evidence to support the position that flame retardant selection, when used in effective amounts, is critical within polyurethane adhesive systems.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
June 9, 2003


RABON SERGENT
PRIMARY EXAMINER